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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,693	01/16/2002	Petra Hingsen-Gehrmann	56268US012	1414

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

EGAN, BRIAN P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 06/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary	Application No.	Applicant(s)	
	10/051,693	HINGSEN-GEHRMANN ET AL.	
	Examiner	Art Unit	
	Brian P. Egan	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2 and 4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a tamper-indicating article, classified in class 428, subclass 343.
 - II. Claims 13-16, drawn to a method of using a tamper-indicating article, classified in class 427, subclass 163.4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using the product. For example, the tamper-indicating article need not be used as a label or sticker. Instead, it may be used as a seal for a product or as a tape-type product used to join two substrates. Furthermore, as claimed, Claims 13-16 provide for the use of the tamper evident container, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Therefore, it should be noted that Claims 13-16 are rejectionable under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a

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proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ms. Carolyn Fischer on May 14, 2003 a provisional election was made with traverse to prosecute the invention of group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Interpretation

6. The Examiner notes that the Claim 1 limitation “wherein the article exhibits an interlayer cohesive failure at the release layer of the retroreflective sheet when an attempt is made to remove the article from the substrate surface” has been given little to no patentable weight since it is regarded as functional language and is not phrased in accordance with 35 U.S.C. 112, sixth

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paragraph. The Examiner suggests the use of a means-plus function (see MPEP 2181-2184).

For Example, “wherein the article comprises a tamper indication means for exhibiting an interlayer cohesive failure at the release layer of the retroreflective sheet when an attempt is made to remove the article from the substrate surface” would be in accordance with 35 U.S.C.

112, sixth paragraph.

7. The Claim 11 limitation that the pressure sensitive tape is removed “by stretching said film or said tape” is considered a process limitation by the Examiner and has therefore been given little to no patentable weight. The process of using the device is not germane to the issue of patentability of the device itself. To lend patentable weight to the stretching ability of the tape, the Examiner suggests replacing the phrase “a pressure-sensitive adhesive coated tape that can be removed from the substrate surface, without exhibiting cohesive failure, by stretching said film or said tape” with the phrase “a pressure-sensitive adhesive coated stretch removable tape wherein the stretch removable tape is removable from the substrate surface without exhibiting cohesive failure.”

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention.

The phrase “can be” is indefinite. The Examiner suggests replacing the limitation comprising “can be” with the phrase “a pressure-sensitive adhesive-coated tape that is removable from the

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substrate surface” to facilitate clarity (or with the suggested phraseology above with regards to the stretching ability of the tape). Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 99/55791 (hereinafter WO ‘791).

WO ‘791 discloses a tamper-indicating article for attachment to a surface of a substrate comprising an adhesive layer and a retroreflective sheet (see Abstract). The retroreflective sheet comprises a reflective layer (pg. 12, lines 13-18), a non-silicone-based discontinuous release layer adjacent to the reflective layer (note that the release layer is selected from either silicone or non-silicone containing release layers – pg. 11, lines 19-23), and a layer of lenses overlying the release layer and positioned in optical connection with the reflective layer so as to produce retroreflection (pg. 12, lines 4-13). The article exhibits an interlayer cohesive failure at the release layer of the retroreflective sheet when an attempt is made to remove the article from the substrate surface (Fig. 3; pg. 11, line 28 to pg. 12, line 3). The retroreflective sheet further comprises an ink layer, the ink layer located between the reflective layer and the adjacent release layer (“indicia comprising ink” – pg. 8, lines 15-16). The article substantially retains interlayer cohesive failure characteristics when exposed to simulated long-term exposure to heat on a glass

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windshield (i.e. 40 days at 70°C) (p.25, lines 6-9) – therefore, the article inherently retains interlayer cohesive failure at the less extreme conditions as claimed by the Applicant (24 hours at 23°C and 50% relative humidity). The retroreflective sheet exhibits a tensile strength at break greater than 7.8 N/mm² and an elongation at break greater than 40% (p.21, Table 1) – note also that the tensile strength and elongation at break are modifiable based on the elasticity or brittleness of the various layers, the adhesion between adjacent layers, the thickness of the layers, and the pattern of the discontinuous release layer, as well as the removal direction, angle, force, and speed and the temperature during removal (pg. 10 line 28 to pg. 11 line 1). The retroreflective sheet has two major surfaces and the adhesive layer is adjacent to the major surface of the retroreflective sheet near the reflective layer and distant to the layer of lenses of the retroreflective sheet (Fig. 2, #40). The reflective layer comprises at least one set of axial markings which are viewable as an image from the front-side of the retroreflective sheet within a limited range of angles (pg. 14 line 23 to pg. 15 line 30). The adhesive layer is a pressure-sensitive adhesive layer wherein the pressure sensitive adhesive layer is a film of pressure sensitive adhesive or a pressure sensitive adhesive coated tape that is removable from the substrate surface without exhibiting cohesive failure by stretching the film or the tape (pg. 4 line 16 to pg. 5 line 17).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '791 in view of JP 57-044679 (hereinafter JP '679).

WO '791 teaches a tamper-indicating article as detailed above. Although WO '791 teaches that the release layer may be any release material known in the art (pg. 11, line 20) and thus may be selected from silicone and non-silicone containing materials, WO '791 fails to explicitly state that polyester resins, polyacrylate resins, or mixtures thereof may be used as the release material. It is notoriously well known in the art, however, to use polyester release material as evidenced by JP '679 (see Abstract). JP '679 teaches the use of polyester release material for the purpose of providing a coated film that easily and perfectly releases from other substrates (see Abstract). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have selected a polyester release material for a tamper-indicating article for the purpose of providing a coated film that easily and perfectly releases from other substrates as taught by JP '679.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified WO '791 by replacing the release material with a polyester release material as taught by JP '679 in order to provide a coated film that easily and perfectly releases from other substrates. Furthermore, even in the absence of the teachings of JP '679, it would have been obvious to select either a polyester or polyacrylate resin as the release material in WO '791, since it has been held to be within the general skill of a worker in

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the art to select a known material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


BPE
May 28, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/28/03